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EXAMINER

NGUYEN, DUC MINH

ART UNIT PAPER NUMBER

2643

DATE MAILED: 01/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

N.M.

## Office Action Summary

Application No.

09/475,531

Applicant(s)

CONLEY, W. DAVID

Examiner

Duc Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-17 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-11 and 18-25 is/are rejected.
- 7) ☒ Claim(s) 4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, there are two second databases. It is not clear to the examiner that the two second databases are the same or not. The examiner will treat them as if there is only one second database.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 7-11, 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casner (4,517,411) in view of Freeman (6,020,980).

Consider claims 1-2, 7, 18. Casner teaches a method for charging a fee for a telephone call direct to a called telephone number, comprising generating a false dial tone (dial tone generated by the PBX or PABX; col. 3, ln. 38-49); receiving the called telephone number and billing information (col. 3, ln. 50 to col. 4, ln. 17); maintaining the false dial tone (col. 3, ln. 38 to

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col. 4, ln. 26); if the billing information is valid (col. 4, ln. 18-26), the releasing the false dial tone; seizing a true dial tone (dial tone provided by the DDD network; col. 4, ln. 18-22); and placing the telephone call to the called telephone number (col. 3, ln. 38 to col. 4, ln. 26).

Casner does not teach charging a set activation fee for the telephone call.

Freeman teaches that it was well known to charge a set activation fee for the telephone call (the use of a hotel/motel phone or facsimile machine; col. 1, ln. 52-65. It is noted that a hotel/motel utilizes its own PBX/PABX). It is also well known that the set activation fee is the same for every telephone call placed from the set activation fee telephone (e.g., \$5.00 in most hotel and 35.00-55.00 cents at public payphone.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Freeman into the teachings of Casner, so that the telephone owner can earn some profits from providing telephone service for the guest.

Consider claims 3, 5, 21-22. Casner in view of Freeman further teaches determining whether the originating number corresponds to an entry in a billing database (col. 3, ln. 64 to col. 4, ln. 17).

Consider claims 8-10. Casner teaches a method for charging a fee for a telephone call direct to a called telephone number, comprising receiving the called telephone number and billing information (col. 3, ln. 50 to col. 4, ln. 17); determining whether the billing information is present within a first database (col. 3, ln. 57 to col. 4, ln. 12); determining whether a telephone number corresponding to the pay telephone is present within a second database (col. 3, ln. 57 to col. 4, ln.

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12); in the event that the billing information is present in the first database, placing the telephone call (col. 4, ln. 18-26); otherwise, informing the caller that the telephone call may not be placed (col. 4, ln. 12-17); and determining whether the telephone number corresponding to the pay telephone is present in the second database (col. 3, ln. 57 to col. 4, ln. 12). It is further noted that the database in Casner inherently functions as the first and second databases.

Casner does not teach in the event the telephone number corresponding to the pay phone is present in the second data base, charging a set activation fee for the telephone call.

Freeman teaches that it was well known to charge a set activation fee for the telephone call (the use of a hotel/motel phone or facsimile machine; col. 1, ln. 52-65. It is noted that a hotel/motel utilizes its own PBX/PABX).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Freeman into the teachings of Casner, so that the telephone owner can earn some profits from providing telephone service for the guest.

Consider claim 11. Casner in view of Freeman further teaches the billing information comprises the group of credit card (col. 3, ln. 45-49) or a telephone account number (col. 3, ln. 64 to col. 4, ln. 17).

Consider claim 19. Casner in view of Freeman teaches using the call parameters and activation fee to compute a charge for the telephone call (col. 4, ln. 22-26).

Consider claim 20. Casner in view of Freeman further teaches determining the called telephone number and the billing information originated from a telephone having an originating

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telephone number (col. 3, ln. 57 to col. 4, ln. 17); and determining the originating telephone number is associated with a set activation fee pay phone (see Freeman, the use of a hotel/motel phone or facsimile machine; col. 1, ln. 52-65. It is noted that a hotel/motel utilizes its own PBX/PABX).

Consider claim 23. Casner teaches a method for calculating charge for a telephone call, comprising monitoring a telephone call placed to a called telephone number (col. 4, ln. 22-26); determining whether the telephone call originated from a telephone having an originating telephone number that corresponds to an entry in a database (col. 3, ln. 57 to col. 4, ln. 17); and calculating the charge for the telephone call (col. 4, ln. 22-26).

Casner does not teach determining and charging a set activation fee for the telephone call, the activation fee is independent from the charge for the telephone call.

Freeman teaches that it was well known for a hotel/motel to charge a set activation fee for the telephone call (the use of a hotel/motel phone or facsimile machine; col. 1, ln. 52-65. It is noted that a hotel/motel utilizes its own PBX/PABX). It would have been obvious that the activation fee is independent from the charge for the telephone call (for instance, the guest uses a credit card to make a long distance call. The hotel/motel charge the guest \$5.00 for activation fee. The phone company charges the guest for the long distance call.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Freeman into the teachings of Casner, so that the telephone owner can earn some profits from providing telephone service for the guest.

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Consider claim 24. Casner further teaches the limitations of claim 24 in (col. 4, ln. 22-26).

Consider claim 25. Casner further teaches prior to placing the telephone call, determining whether billing information for the telephone call is valid (col. 3, ln. 57 to col. 4, ln. 17).

***Allowable Subject Matter***

4. Claims 12-17 are allowed over the prior art of record.
5. Claims 4, 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 308-6306 or (703) 308-6296** (Group's Fax numbers)  
**(703) 746-7251** (Examiner's Fax number, only for proposed amendment)

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

January 11, 2002



**DUC NGUYEN**  
**PRIMARY EXAMINER**